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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,857	07/31/2003	Robert Wiest	341019US28	9086
22850 7590 06/15/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER CARTER, CANDICE D				
ART UNIT 3629		PAPER NUMBER		
NOTIFICATION DATE 06/15/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/630,857

**Applicant(s)**

WIEST ET AL.

**Examiner**

CANDICE D. CARTER

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-7, 9-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-889)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is a First Action Non-Final on the merits. Claims 1-7, 9-16, and 18-22, are currently pending and have been considered below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 26, 2009 has been entered.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 18-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 18-22 are directed towards a method for transacting business between a solicitor and a business comprising receiving information, evaluating information, determining whether data is complete and whether it falls into one of two pathways.

Examiner contends that a process must be (1) tied to another statutory class (such as a particular machine) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

An applicant may show that a process claim satisfies 35 U.S.C. § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. *In re Bilski*.

In the instant case, the machine involvement with respect to these method claims is considered to be merely insignificant extra-solution activity and. Therefore, these method claims are not considered to be statutory.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-7, 9-16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,794,207) in view of Mangin et al. (6,078, 890) and further in view of Case (6,510,418).**

As per claim 1, Walker et al. discloses "A system for transacting business between a solicitor and a business comprising:

a server used by a business and being accessible by a solicitor" (col. 8, line 42-52 discloses communications between buyers and sellers being conducted using a central controller where a buyer who wishes to make a purchase accesses the central controller located at a remote server; in the instant case, the buyer is the solicitor as he is soliciting the business of sellers accessing the system);

"and a contract evaluator housed on the server, wherein the contract evaluator receives input data from the solicitor and determines at a second stage whether the input data as a whole falls within at least two specific pathways of further data evaluation" (col. 18, line 17-26 discloses evaluating the CPO by extracting data from the data input fields to determine the appropriate subject area that CPO would fall under, where the appropriate subject area is the specific pathway).

Walker et al. discloses the claimed invention except for "at least two specific pathways". It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and apparatus designed to facilitate buyer driven conditional purchase offers of Walker et al. to include at least one additional pathway, since it has been held that mere duplication of the essential working apparatus of a device involves only routine skill in the art. *St. Regis paper Co. v. Bemmis Co.* 193 USPQ 8.

Walker et al., however, fails to explicitly disclose "determines at a first stage whether the input data is complete, and error free in accordance with error validation criteria, to receive further evaluation" and "at least two specific pathways of further data evaluation, a first of the specific pathways being automatic and used when the input

data fits within an acceptable range that is predetermined by the system, the acceptable range being an ideal range of acceptable premiums and the input data including at least a premium from the solicitor, and a second of the pathways being semi-automatic and used when the input data falls outside of the acceptable range that is predetermined by the system, processing associated with the second of the specific pathways ultimately necessitating manual intervention by an expert".

Mangin et al., discloses a method and system for automated health care renewal and quality assessment having a stage wherein input data is determined to be complete, and error free in accordance with error validation criteria. (col. 4, line 6-11 discloses an electronic form determining whether the provider failed to fully input all requested data into the form, where the failure to input all requested data into the form is an error and where the programming that analyzes the form to determine any failures, inherently uses error validation criteria in order to determine that there has been a failure).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and apparatus designed to facilitate buyer driven conditional purchase offers of Walker et al. to include the electronic form notifying a user of incomplete data input fields as disclosed by Mangin et al. in order to facilitate the proper processing of the form and the information associated with it.

Case et al. discloses at least two specific pathways of further data evaluation, a first of the specific pathways being used when the input data fits within an acceptable

range that is predetermined by the system, the acceptable range being an ideal range of acceptable bids and the input data including at least a bid from the solicitor, and a second of the pathways being used when the input data falls outside of the acceptable range that is predetermined by the system, processing associated with the second of the specific pathways (col. 6, line 36-col. 7, line 58 and Fig. 6A-7B discloses at least two pathways representing an acceptable range and an unacceptable range).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and apparatus designed to facilitate buyer driven conditional purchase offers of Walker et al. to include the multiple pathways representing an acceptable range and an unacceptable range of Case et al. in order to prevent ping-pong by the solicitors.

Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In the instant case, what the specific pathways is used for, in the system claim, is considered to be intended use. In addition, in the method claim, the function of the specific pathways is not positively recited in the claim language. Moreover, the manual intervention that is necessitated by the nature of the second pathway, also, does not carry any patentable weight because it is not positively recited in the claim language.

The Examiner would like to note that although, prior art has been applied to the all limitations of the claims, that for the above reasons, the elements identified do not represent limitations in any patentable sense.

Claims 10 and 18 recite equivalent limitations to claim 1 and are therefore rejected using the same art and rationale as set forth above.

As per claim 2, Walker et al. discloses all of the elements of the claimed invention but fails to explicitly disclose "if the input data is not complete at the first stage then the solicitor is alerted to complete the input data".

Mangin et al. discloses a method and system for automated health care renewal and quality assessment having an alert operable to notify the solicitor to complete the input data (col. 4, line 9-11 discloses that an alert is provided to inform the provider of the failure to complete all data fields)

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and apparatus designed to facilitate buyer driven conditional purchase offers of Walker et al. to include the electronic form notifying a user of incomplete data input fields as disclosed by Mangin et al. in order to facilitate the proper processing of the form and the information associated with it.

Claims 11 and 19 recite equivalent limitations to claim 2 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 3, Walker discloses all of the elements of the claimed invention but fails to explicitly disclose "the contract evaluator determines at the second stage

whether the input data as a whole falls with one of the at least two specific pathways based on one or more rules, the one or more business rules being associated with a reinsurance business model".

Mangin et al., discloses a method and system for automated health care renewal and quality assessment having rules associated with a reinsurance business model (col. 3, line 1-20 discloses calculating managed care price proposals that differ in structure according to a myriad of complex factors including provider type, coverage type, and employee work status, where the price proposals, inherently, are determined according to rules associated with the different types of coverage policies).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and apparatus designed to facilitate buyer driven conditional purchase offers of Walker et al. to include rules associated with a reinsurance business model since such would facilitate the determination of monthly total composite insurance rates.

Case et al. discloses the contract evaluator determines at the second stage whether the input data as a whole falls with one of the at least two specific pathways based on one or more rules (col. 6, line 36-col. 7, line 58 and Fig. 6A-7B discloses determining whether bids fall within at least two pathways representing an acceptable range and an unacceptable range based on rules).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and apparatus designed to facilitate buyer driven conditional purchase offers of Walker et al. to include the multiple

pathways representing an acceptable range and an unacceptable range of Case et al. in order to prevent ping-pong by the solicitors.

Furthermore, Examiner considers the specific type of business model to be nonfunctional descriptive material as recited. The specific type of business model does not change the function of the claimed invention. Examiner asserts that the method and apparatus designed to facilitate buyer driven conditional purchase offers of Walker is fully capable of using rules associated with any type of business model.

Claims 12 and 22 recite equivalent limitations to claim 3 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 4, The Walker et al. and Mangin et al. combination discloses all of the elements of the claimed invention but fails to explicitly disclose "each of the one or more specific pathways has a prerequisite of a given range of variables".

Case et al. discloses a method and apparatus for detecting and deterring the submission of similar offers in a commerce system having "a prerequisite of a given range of variables" (col. 6, line 36-48 discloses unacceptable similarity ranges indicating a range for the corresponding term within which similar buyer offers may be rejected, where the acceptable range is any value falling outside of the unacceptable similarity range).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and apparatus designed to facilitate buyer driven conditional purchase offers of the Walker et al. and Mangin et al.

combination to include the prerequisite of a given range of variables as taught by Case et al. since such would filter out all offers/counteroffers that are unacceptable.

Claims 13 and 20 recite equivalent limitations to claim 4 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 5, The Walker et al. and Mangin et al. combination discloses all of the elements of the claimed invention but fails to explicitly disclose "a default pathway is followed if the input data does not fall within any of the one or more specific pathways" (col. 9, line 4-16 discloses that if an offer is determined to fall outside of the acceptable offer range then an alternate or default process is followed, where the default process could be to reject the offer, charge a surcharge to process the offer, or providing a warning, or suspending future privileges of the buyer).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and apparatus designed to facilitate buyer driven conditional purchase offers of the Walker et al. and Mangin et al. combination to include the default pathway as taught by Case et al. since such would deter users from submitting offers that fall outside of an acceptable range.

Claims 14 and 21 recite equivalent limitations to claim 5 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 6, Walker et al. further discloses "one or more of the specific pathways accepts the input of the solicitor and signals the solicitor that a contract has been formed". (col. 18, line 16-17 discloses the central controller extracting data from the CPO and col. 19, line 42-45 discloses the seller adding an indication to the CPO

that the contract is agreed to, where this indication would, inherently, be communicated to the solicitor)

Claim 15 recites equivalent limitations to claim 6 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 7, Walker et al. discloses "one of the one or more specific pathways presents the solicitor with a counteroffer" (col. 22, line 40-42 discloses a seller responding to a solicitor with a counteroffer).

Claim 16 recites equivalent limitations to claim 7 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 9, Walker et al. discloses "one of the one or more specific pathways signals the solicitor that a contract cannot be formed" (col. 9, line 45-50 discloses that a seller may respond to a CPO by sending a counteroffer through the central controller, where, by sending the counteroffer, the central controller is notifying the solicitor that the contract cannot be formed because the seller did not agree to the original terms of the contract).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 3, 10, 12, 18, and 22 have been considered but are moot in view of the new ground(s) of rejection.

In response to arguments in reference to claims 2, 4-7, 9, 11, 13-16, and 19-21 all rejections made towards the dependent claims are maintained due to a lack of reply by the applicant in regards to distinctly and specifically pointing out the supposed errors in the examiner's prior office action (37 CFR 1.111). The Examiner asserts that the

applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and patentable over the prior art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDICE D. CARTER whose telephone number is (571) 270-5105. The examiner can normally be reached on Monday thru Thursday 7:30am- 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629